

REMARKS

This responds to the Office Action dated August 8, 2006.

No claims have been amended. Claims 1, 3-16, 18-22, and 24-26 remain pending in this application. Applicant notes that no rejection has been proffered against claims 12, 13, and 14. Applicant respectfully requests the Office to indicate allowability thereof if the claims are rewritten to include the independent claim and all intervening claims. Detailed responses to the rejections of the Office Action are as follows:

§102 Rejection of the Claims

Claims 1, 4, 16 and 19-21 were rejected under 35 U.S.C. § 102(b) as being anticipated by Bush (U.S. Patent No. 5,755,762). The Applicant respectfully traverses the rejection and requests the Office to consider the following.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), M.P.E.P. §2131, 8th Ed., Rev. 4).

The Office admits that Bush does not teach or suggest expanded ultra-high molecular weight polyethylene. With respect to anticipation rejections, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

By admission of the Office, Bush does not teach expanded ultra-high molecular weight polyethylene. Withdrawal of the rejection is respectfully requested.

Claims 1, 3-11, 16 and 18-21 were rejected under 35 U.S.C. § 102(e) as being unpatentable over Soukup et al. (U.S. Patent No. 6,704,604) in view of Bush (U.S. Patent No. 5,755,762). Applicant respectfully traverses the rejection and requests the Office to consider the following.

As a point of order, Applicant notes this rejection is improper. A rejection under Section 102 of the Patent Statute must originate “in a single prior art reference.” (*Verdegaal Bros., supra*). Because this anticipation rejection cites two references, this rejection is improper on its face and should be withdrawn. Withdrawal of the rejections is respectfully requested.

§103 Rejection of the Claims

Claims 15, 22 and 24-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukup et al. (U.S. Patent No. 6,704,604) in view of Bush (U.S. Patent No. 5,755,762), as applied above, and further in view of Czura et al. (U.S. Patent No. 5,562,715). Applicant respectfully traverses the rejection and requests the Office to consider the following.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (M.P.E.P. § 2143 8th Ed, Rev.4).

The Office Action admits that “Soukup … fails to teach that the porous covering may included ‘expanded ultra-high molecular weight polyethylene.’ ” (Office Action at page 4). Further as set forth above, by admission of the Office, Bush also does not teach expanded ultra-high molecular weight polyethylene. The Office Action also admits that “Soukup … fails to disclose a dielectric coating over the metallic can, and a passageway through the dielectric coating to form an exposed portion of the container. Consequently by this admission, Soukup

fails to teach at least two claim limitations. The Office turns to Czura to remedy the deficiencies of Bush and Soukup. But Czura also fails to teach an expanded ultra high molecular weight polyethylene. Because all the claim limitations are not taught in the cited references, withdrawal of the rejection is respectfully requested.

The Office also asserts that “Applicant has not disclosed that the use of ‘expanded ultra high molecular weight polyethylene’ as opposed to the other porous materials of original claim 2 solves any stated problem etc.” Applicant respectfully disagrees. The Office cited to page 10, for example, of Applicant’s disclosure. But the Office will note that the various materials are taught separately, but claimed (previously) in claim 2. This is neither an admission of equivalency nor of an “obvious matter of design choice” (Office Action at page 5). Consequently the assertion by the Office, regarding any distinction taught or implied for expanded ultra high molecular weight polyethylene over other materials found in canceled claim 2, is without foundation. Withdrawal of the rejection is respectfully requested.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

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Serial Number: 10/662,129

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Title: EXPANDED ULTRA-HIGH MOLECULAR WEIGHT POLYETHYLENE IN AN ELECTRICAL MEDICAL DEVICE

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6912 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

DANIEL J. COOKE ET AL.

By their Representatives,

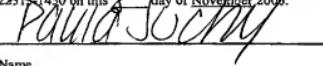
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22314-1450 on this 8 day of November 2006.

Name 

Signature 